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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,982	12/21/2001	Andreas Engelsberg	10191/1974	6682

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EXAMINER
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VILLECCO, JOHN M

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 11/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/914,982

Applicant(s)

ENGELSBURG, ANDREAS

Examiner

John M. Villecco

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 14-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed September 6, 2006 have been fully considered but they are not persuasive.
2. Regarding the 112, 1<sup>st</sup> enablement rejection as applied to claims 14-37, applicant argues that contrary to the examiner's assertion, the claims are enabled as of the date of filing. More specifically, on page 13 of the applicant's response, applicant argues that one of ordinary skill in the art would understand the term probability and its calculation. Applicant goes on to define probability as a measure for the confidence that a specific statement can be made or that a specific event will occur, and that probabilities are often expressed in figures, by numerical values between 0 and 1. The examiner agrees with the definition of probability as defined above. However, the question is not whether one would understand what probability is. The question is whether one of ordinary skill in the art would be enabled to use a probability to specify and fix a position and dimensions as a function of the probability. In this regard, it is the examiner's position that one of ordinary skill in the art would not be enabled to use the probability to specify and fix a position and dimensions as a function of the probability.
3. Applicant goes on to point out portions of the specification that applicant believes enables the specification as it pertains to the claims. Applicant points out page 14, lines 11-16 and which discloses that the probability that the image displacement occurs without additional movement is determined at different positions of an image. This section merely states that the probability is determined and used to specify and fix positions within the image. There is no

information on how the probability is determined or how this probability number is used to specify and fix positions within the image. More specifically, in applicants first preferred embodiment of a special recording situation using a speaker it seems like the three predetermined regions are already set and that a probability is not used to specify and fix these regions. On page 14, lines 21-23 of the substitute specification, applicant states that “the special characteristics of the recording situation are used as a priori knowledge in selecting and fixing image regions”. The examiner interprets this as using the recording situation (i.e. recording a speaker) to specify and fix image regions. Furthermore, there is no discussion of how the calculated probability (discussed in the substitute specification on page 14, lines 11-13) is used in determining the special recording situation.

4. Additionally, applicant states in his response that page 15, line 7-12 discloses that the probability can also be determined using criteria such as edge detection or absence of edge detection. However, the examiner can find no mentioning in this passage of the edge detection or absence of edge detection being used to calculate a probability. Applicant also points out page 1, lines 22-31 and page 15, lines 14-19 as supposedly enabling the claims for specifying and fixing a position and dimensions as a function of a determined probability. However, these sections do not describe how the probability is determined and used to specify and fix a position and dimension of the image regions.

5. MPEP § 2164.06(a) states that an adequate disclosure of a device may require details of how complex components are constructed and perform the desired function. See *In re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974). It is the opinion of the examiner that the applicant has not provided enough detail in the specification of how the probability is

Art Unit: 2622

determined and then used to specify and fix a position and dimension of the image regions as a function of the determined probability. The applicant has merely stated that a probability is used and has not described the complicated manner in which it is being determined and used.

6. Applicant further argues that the examiner has not fully met the requirements for determining whether a patent application complies with the enablement requirement that the specification describe how to make and use the invention as described in MPEP § 2164. The applicant contends that the examiner's analysis must consider all of the evidence related to each of the In re Wands factors, since it is improper to conclude that a disclosure is not enabling based on an analysis of only one of the In re Wands factors. However, MPEP § 2164.04, 5<sup>th</sup> paragraph states that it is not necessary to discuss each of the factors. This section states that "the language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation". Since the examiner has evaluated the claims in light of In re Wands taking into consideration the most compelling evidence, the examiner has met the initial burden of establishing a prima facie case.

7. For the reasons stated above, the rejections from the previous office action will be repeated.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 2622

9. Claims 14-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

More specifically, in accordance with MPEP § 2164, the examiner has the initial burden of establishing a prima facie case of lack of enablement. The question posed when making a lack of enablement rejection is: Is the experimentation needed to practice the invention undue or unreasonable? See *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916). The test for lack of enablement was established in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) and set forth several factors which must be considered by the examiner when making a determination of lack of enablement. These factors can be found in MPEP § 2164.01(a). Furthermore, the examiner need not discuss every factor. The examiner need only to focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation.

### **B) The nature of the invention**

This invention is directed toward a method of determining the displacement of images in an image sequence. More specifically, the invention is directed toward using a probability of image movement occurring and using that probability of image movement to specify and fix a position and dimensions of the plurality of image regions.

**C) The state of the prior art**

After a thorough prior art search a determination has been made that a lot of work has been done in determining a displacement of images in an image sequence, but no prior art has been found that uses a probability of image movement occurring without additional movement to specify and fix a position and dimension of image regions. The closest prior art that has been found is the Egusa reference (U.S. Patent No. 5,237,405) which uses a reliability factor to judge the degree of correlation. However, as mentioned in the applicant's response filed August 11, 2005, the reliability determination of Egusa cannot be interpreted to be a probability.

**D) The level of one of ordinary skill in the art**

The examiner is of the opinion that it is well known in the art to determine a movement within an image from the background of the image, but one of ordinary skill in the art would not have known how to calculate a probability and then use that probability to specify and fix a position and dimensions of the image regions. Proof of this lies in the fact that no prior art has been found that uses a probability to determine set the position and dimensions of the image regions.

**F) The amount of direction provided by the inventor**

In the specification the concept of probability is only mentioned a couple of times. Further, there is no description of how the probability is calculated or how that probability is used to specify and fix the position and dimensions of the image region. A probability is mentioned on page 1, line 27 of the substitute specification and page 14, lines 11-19. However,

Art Unit: 2622

these sections do not elaborate on how the probability is calculated or used in the present invention. On page 14, lines 11-19, the inventor merely states that “the probability of the image movement occurring at various positions of the images of an image sequence without the additional movement is determined.” The inventor also states that “this results in preferential portions inside the image which can be used for separating the image movement from the additional movement.” However, this appears to be the only detail that is given on the determination of a probability. One of ordinary skill in the art would not be enabled to make and or use a probability to specify and fix a position and dimension of the image regions.

**G) The existence of working examples**

There is no mention of a working example, nor any example of using a probability to specify and fix a position and dimension of the image regions in any of the prior art.

**H) The quantity of experimentation needed based on the disclosure**

Since using a probability to specify and fix a position and dimension of the image regions does not appear to be something that has been used before, the disclosure should be enabling enough for one of ordinary skill in the art to make and/or use the invention. As mentioned previously, the only mentioning of probability occurs on page 1, line 27 of the substitute specification and page 14, lines 11-19. However, these sections do not elaborate on how the probability is calculated or used in the present invention. One of ordinary skill in the art would have to engage in undue experimentation in order to figure out how to use a probability to specify and fix a position and dimensions as a function of the probability. Therefore, since the



specification provides no detail on how to calculate the probability or how to use the probability to specify and fix the dimensions and positions of the image regions, the disclosure is non-enabling. See MPEP § 2164.06.

For the reasons discussed on the previous pages, the examiner maintains that claims 14-37 are non-enabled in view of the specification.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (571) 272-7319. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John M. Villecco  
November 14, 2006